

### **Remarks**

This amendment is responsive to the official action of February 5, 2007 and is accompanied by a one month extension and fee under 37 C.F.R. §1.136(a).

In the official action, allowable subject matter was indicated for claims 17 and 18. Claim 17 has been placed in allowable form by combining its subject matter with that of base claim 1 and intermediate claim 16. Claim 18 depends from claim 17. Claims 17 and 18 are thus allowable in accordance with the official action.

Claim 1 and the other claims that depended from claim 1 were rejected under 35 U.S.C. §103 as obvious from alternative combinations of US Patent 5,653,254 – Condon with one or more of US Patents 6,129,109 – Humber; 754,414 – Bossert; or 4,053,082 – Ullman. Condon is newly cited in this action and in each of the rejection is relied upon to support modification of a flush mounting box to employ mounting eyes, extending from the sidewalls adjacent to the base, as defined in applicant's claim 1. Such mounting eyes are exemplified by eyes 2 in elected Figs. 6-8.

Claim 1 has been amended to better distinguish over the combinations put forth in the official action in the rejections under Section 103. Claim 1 as amended defines where and in what direction the claimed eyes protrude, namely outwardly from the outer surface of the sidewalls adjacent to the base. This location and orientation of applicant's mounting eyes enables fasteners such as bolts passing through the eyes to attach the flush mounting box to a surface disposed behind or under the base of the flush mounting box. Such a structure is not shown in or suggested by Condon.

Applicant has mounting eyes 2 on the sidewalls, extending outwardly from the sidewalls at a point on the sidewalls adjacent the base. Condon's analogous eyes 39a,

39b extend rearwardly from the base, at a point on the base adjacent to the sidewalls. In other words, Condon's attachment features are on different walls compared to the claimed eye structures and extend in a direction that is orthogonal to the direction of extension in the claimed eye structures.

The location and orientation of the protruding eyes (or straps or tabs or ears or another such designation) that receive the fasteners that affix a flush mounting box to other building elements, are more than simple routine design choices. These aspects of location and orientation can affect whether and how the box can be affixed using fastening structures that engage with the eyes.

Applicant's claimed eyes, disposed on the outer surfaces of the walls near the base, and oriented to protrude radially outwardly, are configured to receive fasteners that are directed perpendicular to the plane of the base. Fasteners through applicant's eyes affix the box to a surface behind and parallel to the base. The box can be bolted with the base against that surface, or in certain embodiments, the fastener holds the box at a space from such surface. This arrangement for mounting the box on a rear surface is claimed together with the aspect of a selectively placed front flange (i.e., selectively located nearer or farther from the base).

The claimed invention would not result from any routine combination of Condon with the other prior art of record. Furthermore, Condon alone or with the other cited references does not teach or suggest modifications leading routinely to the claims as a whole.

According to Condon (col. 3, lines 47-53), mounting straps 39a, 39b extend rearwardly (not outwardly) from the lower portions of the sidewalls 34a, 34b, and as shown in Fig. 2, it appears that the straps more specifically extend rearwardly on the surface of the base adjacent to the sidewall. The straps have slots in their rear ends for receiving nails that can be driven into an adjacent stud. The stud is disposed laterally alongside the box and thus the ears are flush with the sidewalls.

The Condon straps can be affixed to an adjacent stud only by a fastener that is oriented substantially perpendicular to the sidewall, i.e., along the plane of the base, at a position that is behind the body of the box. The Condon straps cannot be affixed to a surface that is rearward of the base. In that direction the Condon straps would be oriented endwise to the surface. Condon does not meet or suggest applicant's claimed invention.

One must conclude from Condon's straps for attachment to the studs that the Condon box is mounted before the drywall or other building wall surface is constructed. A lateral fastener through a strap oriented as shown behind the box would be inaccessible to be set in place if attempting an installation from the front through a typical hole in a wall panel.

Such aspects of Condon are not readily combinable with the other prior art of record and if combined would not meet all the aspects of the invention as particularly claimed. In Humber, the box is likewise attached to the stud as in Condon. Humber has straps 40 on the outer face of the studs. If Condon and Humber are combined, Condon's straps 39a, 39b could be moved to the location of Humber's straps 40, or Humber's straps 40 could be bent to the rear for attachment on the side faces of the studs. Neither arrangement would resemble applicant's invention, wherein the eyes that extend outwardly from the sidewalls permit an attachment to a wall surface behind the base of the box.

Condon and Humber don't address the possibility that there might be a wall surface existing behind the flush mounting box. Condon's lateral fastener direction appears to require mounting before the wall is constructed. Humber shows the mounting when the wall consists only of roughed-in studs (Figs. 5B, 5C). Nowhere does the prior art address how one might flush mount a box so that a rim is defined at the drywall or other surface relative to a box that is securely affixed to a wall surface at an indefinite space behind the drywall surface. The prior art lacks applicant's claimed

structure and provides no guidance that might lead a person of ordinary skill to configure a flush wall box in the manner claimed as a whole.

The combinations of Condon with Bossert or Ullman also do not meet the invention. Bossert lacks any teachings for supporting a box by attaching the box to structures other than the facing panel of drywall or the like. Ullman has holes 48 through which fasteners could be placed through the base inside the box. But Ullman has a fixed flange 42 on the rim of the box. The idea there is for a ring member 20 to thread via cam tracks 39 on pins 44 to oppose the fixed flange 42 like a nut on a bolt. There is no basis to believe that the invention claimed as a whole might be in reach of a person of ordinary skill making a routine application of the teachings of these references.

The claims have been amended to better define the subject matter of the invention and more clearly to distinguish over the prior art of record. The differences between the invention and the prior art of record are such that the subject matter claimed, as a whole, is not shown to have been known or obvious. Applicant is pleased to note the indication of allowable subject matter for claims 17 and 18. Claim 1 and the claims depending from claim 1 are also allowable for the reasons stated.

The application is in condition for allowance. Reconsideration and allowance are requested.

Respectfully submitted,

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